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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,363	01/26/2001	Yoshihiro Ishida	35.G2725	4785

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/769,363	<b>Applicant(s)</b> ISHIDA ET AL.	
	<b>Examiner</b> Thierry L. Pham	<b>Art Unit</b> 2624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-13 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 1/31/06.
- Claims 1-2, 5-13, and 16-23 are pending; claims 3-4, and 14-15 have been canceled.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5-13, and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (U.S. 5621810), and in view of Yamakawa et al (US 5809366).

Regarding claim 1, Suzuki discloses an image processing apparatus (copy machine, fig. 2) comprising:

- image-data input means (image scanner 201, fig. 2, col. 4, lines 1-20) for inputting image data;
- specific-image determination means (prohibition pattern detection means, fig. 36, col. 2, lines 1-50 and col. 4, lines 36-64) for determining whether the image data inputted by said image-data input means represents a specific image having predetermined characteristics (i.e. digital watermark, figs. 14-15).

However, Suzuki does not expressly disclose (1) re-input determination means for determining whether to output a signal urging re-input of the image data input by said image-data input means, said re-input determination means including difficulty determination means for determining whether the determination by said specific-image determination means is difficult, wherein said re-input determination means determines whether to output the signal urging re-input of the image data based on the determination by said difficulty determination means; and (2) signal output means for outputting the signal urging re-input of the image data, in accordance with a result of the determination by said re-input determination means.

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Yamakawa, in the same field of endeavor for printing, teaches (1) re-input determination means (image processor 3 of copy machine 1, fig. 4) for determining whether to output a signal urging re-input (warning message for urging user to execute scanning again, col. 14, lines 30-35) of the image data input by said image-data input means, said re-input determination means including difficulty determination means (image processor 3 further includes CPU 517, fig. 18) for determining whether the determination by said specific-image determination means is difficult (col. 14, lines 30-35), wherein said re-input determination means determines whether to output the signal urging re-input (message urging re-scanning of image data, col. 14, lines 30-35) of the image data based on the determination by said difficulty determination means; and (2) signal output means for outputting the signal urging re-input of the image data (message urging re-scanning of image data, col. 14, lines 30-35) by said re-input determination means.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify image processing apparatus of Suzuki to include a re-input means for re-input original image to read again because of difficulty of reading the first scan as per teachings of Yamakawa because of a following reason: (●) to accurately detects security marks/originals by ensuring the inputted image is scanned correctly and accurately; (●) to obtain high quality of outputted documents if the documents are not copy-prohibited by ensuring the documents are properly read/scan.

Therefore, it would have been obvious to combine Suzuki with Yamakawa to obtain the invention as specified in claim 1.

Regarding claim 2, Suzuki further discloses an image processing apparatus according to claim 1, wherein said specific-image determination means determines whether the image data obtained from said image-data input means represents a copy-prohibition image (i.e. money, fig. 14a).

Regarding claim 5, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means comprises difficulty

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calculation means (pattern matching determination means by determining position of protected-pattern with respect to position of the original, col. 2, lines 1-50 and col. 9, lines 18-65) for calculating difficulty in determination whether the image data represents the specific image, and difficulty determination means for determining whether the determination of said specific-image determination means is difficult based on the difficulty calculated by said difficulty calculation means.

Regarding claim 6, Suzuki further discloses an image processing apparatus according to claim 2, wherein said re-input determination means comprises difficulty calculation means for calculating difficulty in determination whether the image data represents a copy-prohibition image, and difficulty determination means (col. 2, lines 1-50 and cols. 9-10) for determining whether the determination whether the image data represents a copy-prohibition image is difficult, based on the difficulty calculated by said difficulty calculation means.

Regarding claim 7, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means determines whether the re-input is to be urged, from data based on a position of an original (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) in an image represented by the input image data.

Regarding claim 8, Suzuki further discloses an image processing apparatus according to claim 5, wherein said difficulty calculation means calculates the difficulty in the determination of the specific image, from data based on a position (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination by said specific-image determination means is difficult, by comparing data of the difficulty calculated by said difficulty calculation means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

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Regarding claim 9, Suzuki further discloses an image processing apparatus according to claim 6, wherein said difficulty calculation means calculates the difficulty in the determination of a copy-prohibition image, from data based on a position (position calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination of a copy-prohibition image is difficult, by comparing data of the difficulty calculated by said difficulty calculation means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

Regarding claim 10, Suzuki an image processing apparatus according to claim 7, wherein data of difficulty calculated from data based on the position of the original in the image represented by the input image data is an angle (angle calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of the original with respect to a scanning direction (fig. 1) of the image represented by the input image data.

Regarding claim 11, Suzuki further discloses an image processing apparatus according to claim 7, wherein data of difficulty calculated from data based on the position of the original in the image represented by the input image data is a deviation (i.e. angular and positional difference, cols. 8-10) of the original from a predetermined position with respect to a scanning direction of the image represented by the input image data.

Regarding claims 12-13, 16-22: Claims 12-13, 16-22 are the method claims corresponding to the apparatus claims 1-2, 5-11. The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-2, 5-11 above.

Claim 23 corresponds to claim 1 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All

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computers/printers have some type of computer readable memory medium (RAM, fig. 4) for storing computer programs; therefore, claim 23 would be rejected using the same rationale as in claim 1.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. A new ground(s) of rejection is made in view of newly found prior art reference *due to newly added features/limitations* as cited in independent claim 1.

Applicant's arguments, see page 9, filed 1/31/06, with respect to claim 23 have been fully considered and are persuasive. The U.S.C. §101 (non-statutory subject matter) rejection of claim 23 has been withdrawn.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER